REMARKS

Claims 1-24 are pending in this patent application (the "Application").

Claims 1-24 have been rejected.

Claims 1-24 remain in the application.

Reconsideration of the claims is respectfully requested.

Specification

The Applicant has amended the specification of the patent application to correct typographical errors. No new matter has been added to the specification as a result of these amendments.

Drawings

The Applicant has amended Figure 2 of the drawings of the patent application to correct the letters "DPD" to read "DAPD." The Applicant has also amended Figure 4 of the patent application to correct "PC 170" to read "PC 105." These corrections are being submitted in a concurrently filed document entitled "Proposed Drawing Changes." No new matter has been added to the drawings as a result of these amendments.

35 U.S.C. § 103(a) Obviousness

In Paragraph 1 on Pages 2-4 of the April 9, 2003 Office Action, the Examiner rejected Claims 1-4, 7-10, 13-17 and 20-24 under 35 U.S.C. § 103(a) as being obvious over United States Patent No. 4,422,105 to *Rodesch et al.* (hereafter "*Rodesch*") in view of "Admit prior Art (page 4)." In Paragraph 2 on Page 5 of the April 9, 2003 Office Action, the Examiner rejected Claims 5, 6, 11, 12, 18 and 19 under 35 U.S.C. § 103(a) as being obvious over *Rodesch* and in view of "Admit prior Art (APA)" and further in view of United States Patent No. 6,442,6587 to *Hunt et al.* (hereafter "*Hunt*"). The Applicant respectfully traverses the Examiner's position that the Applicant's invention is obvious in view of the *Rodesch* reference and in view of the allegedly admitted prior art and in view of the *Hunt* reference. The Applicant respectfully requests the Examiner to withdraw the rejection of Claims 1-24 in view of the Applicant's arguments.

During *ex parte* examinations of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*,

977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

For the reasons set forth below the Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness with respect to Claims 1-24 of the Applicant's invention. In rejecting Claim 1 the Examiner stated:

> As to Claim 1, Rodesch teaches digital audio playback device (video playback device, the video tape recorder, col 2, ln 1-45/ col 3, ln 5-30/ col 4, ln 1-40/col 5, ln 1-20/ col 6, ln 1-15/ col 9, ln 50-68/ col 10, ln 1-5/col 17, ln 49-68), an external interface capable (interface 108, col 9, ln 51-68/ Fig. 4), processing system (computer 64, col 9, ln 51-68, Fig. 4), user interface application program (command input, col 9, ln 51-68)/ user input command, col 3, ln 5-30/ col 4, ln 1-39 col 5, ln 1-20/ col 6, ln 1-15/ col 17, ln 49-68), a memory (scratch pad memory, col 3, ln 20-30/ scratch pad memory 220, col 15, ln 46-68/ col 16, ln 31-45/ col 20, ln 10-32/ RAM 106, col 9, ln 50-68/ col 10, ln 54-68), a reverse DAPD (reverse or forward scan function command/ software routine, col 3, ln 5-30, the software program ... routines col 2, ln 1-47/ col 17, ln 9-64) col 19, ln 5-30), user interface (the keyboard, col 3, ln 5-30), monitor screen (video monitor, col 2, ln 12, ln 18-47/ CRT 42, Fig. 4).
>
> Rodesch does not teach the application program interface (API) for the digital audio playback device. However, APA teaches API that are supported by the digital

> audio playback device (page 4, ln 8-17).
>
> It would have been obvious to apply the teaching of APA to Rodesch in order to provide the interface by which an application program accessed operation system and other services, provides a level of abstraction between the application and to ensure portability of the code. (April 9, 2003 Office Action, Page 2).

The Applicant agrees that the *Rodesch* reference does not disclose the use of an application program interface (API) for a digital audio playback device. The Applicant respectfully traverses the Examiner's assertion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device taught by *Rodesch* to include an application program interface (API) for a digital audio playback device. The Applicant respectfully disagrees with the Examiner's characterization of the subject matter of the *Rodesch* reference.

The *Rodesch* system relates to video playback devices and to a system and method of automatically controlling a video playback device in response to user input to provide an interactive video display. (*Rodesch*, Column 1, Lines 8-12). The *Rodesch* system employs user input data interacting with data contained in the recorded video information to determine the video display produced. (*Rodesch*, Column 2, Lines 15-17). The *Rodesch* system comprises a standard video tape recorder (VTR) 40 modified by the addition of system electronics in an add-on enclosure 44. (*Rodesch*, Column 5, Lines 21-24). The user sends commands to the *Rodesch* system through an external keyboard 46. "A hand-held keyboard control 46 connected by an umbilical cord 48 is used for inputting various commands and responses to the system." (*Rodesch*, Column 5, Lines 24-26).

The digital audio playback device 150 of the present invention is a separate, self-contained, stand alone unit that is capable of operating independently of an external processing system (e.g., personal computer 105). *Rodesch* does not teach the use of a separate, self-contained, stand alone video playback device that is capable of operating independently. The digital audio playback

device 150 of the present invention is capable of downloading digital information (including digital audio programs) from personal computer 105 and then operating independently to use the information and play the audio programs using display 155 and control buttons 160. In contrast, the elements of the *Rodesch* system are not separable. The *Rodesch* system simply receives user input from keyboard 46 to the video tape recorder 40 where to access and play portions of a prerecorded videotape. "Depending on the answer received [from the user], the system will then command the VTR to advance or rewind the tape to a new location, or continue as before. Textual material may also be presented on the screen between live video displays, with the user selecting the "page" of text by means of keyboard control 46." (*Rodesch*, Column 5, Lines 57-62). The simple commands sent by the user from keyboard 46 do not comprise a "user interface application program" as that term is used in the present Application.

Therefore, the *Rodesch* system has no need for an application programming interface (API) of the type described in the present Application. The user interfaces mentioned in the specification of the Application comprise software libraries made available by manufacturers of digital audio playback devices. The software libraries typically consist of device drivers needed to communicate with and control digital audio playback devices over an external connection with a personal computer. (Specification, Page 3, Line 20 to Page 4, Lines 7). The software libraries also contain implementations of application programming interfaces (APIs) that are supported by a digital audio playback device. A user may select an API from more than one type of API to operate the user's digital audio playback device. There is nothing in the *Rodesch* reference that requires the use of an API or anything like an API.

It is also noted that the *Rodesch* reference teaches the use of an analog video playback device. There is no mention in *Rodesch* of digital audio signals. The *Rodesch* data is stored on a tape. "Basically, the system is operated by installing a prerecorded instructional tape 50 on VTR 40." (*Rodesch*, Column 5, Lines 44-46). Digital audio playback devices store digital audio signals on a large non-volatile memory, such as a flash random access memory (RAM) that stores, for example, sixty four (64) megabytes of audio file data. (Specification, Page 1, Lines 15-18). The memory units described in the *Rodesch* reference are not large enough to store digital audio files. *Rodesch* states that "One important feature of the present invention [Rodesch] is the need for only limited memory. Virtually all data used in the control and operation of the system is stored permanently on the prerecorded tape or other video recording medium. RAM 106 and character display RAMs 120 need only be large enough to store data from a limited number of the data dumps on any tape. * * * [T]he amount of preprogrammed memory is relatively small, ..." (*Rodesch*, Column 11, Lines 25-45).

Therefore, the digital video playback device of the present invention would not be obvious in view of the *Rodesch* reference due to the very limited memory capacity of *Rodesch*. The *Rodesch* system would not be able to process digital audio signals.

Interface 108 of *Rodesch* is not an external interface between a digital audio playback device and a connected processing system. Figure 1 (and the accompanying text) of *Rodesch* make it clear that computer 64 and VTR interface 108 of *Rodesch* are both internal to the system electronics enclosure 44. Only keyboard 46 is external to system electronics enclosure 44.

The Applicant respectfully traverses the Examiner's position that the "reverse or forward scan function command / software routine" of *Rodesch* is equivalent to the "reverse DAPD API program" of the Applicant's invention. The word "reverse" in *Rodesch* refers to a user command

to rewind the prerecorded instructional tape 50 in video tape recorder 40. The reverse DAPD API program 260 in RAM 230 in PC 105 and the reverse DAPD API program 360 in RAM 330 in DAPD unit 150 are unique and novel elements of the Applicant's invention. There is no teaching, suggestion or hint of the concept of using a reverse DAPD API program in the prior art (including the allegedly admitted prior art on Page 4 of the specification of the Application).

There is no suggestion or motivation to combine the *Rodesch* reference with an application program interface (API) for a digital audio playback device. Even if the *Rodesch* reference were to be combined with an application program interface (API) for a digital audio playback device the combination would not teach, suggest or even hint at the Applicant's invention as claimed in Claim 1 because neither *Rodesch* nor the prior art discloses the use of a reverse digital audio playback device (DAPD) application program interface (API).

For the reasons set forth above, the Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness with respect to Claim 1 of the Applicant's invention. The Applicant respectfully submits that Claim 1 contains unique and novel limitations and that the rejection of Claim 1 under 35 U.S.C. § 103(a) has been overcome.

The Applicant notes that Claims 2-6 depend directly or indirectly from Claim 1. As previously described, Claim 1 contains unique and novel claim limitations of the Applicant's invention. Therefore, Claims 2-6 also contain the same unique and novel claim limitations of Claim 1 and are therefore patentable over the *Rodesch* reference and the allegedly admitted prior art cited by the Examiner, either separately or in combination.

The Applicant notes that Claim 7 contains unique and novel claim limitations that are analogous to the unique and novel claim limitations of Claim 1. Therefore, Claim 7 is patentable

over the *Rodesch* reference and the allegedly admitted prior art cited by the Examiner, either separately or in combination. The Applicant notes that Claims 8-12 depend directly or indirectly from Claim 7. Therefore, Claims 8-12 also contain the same unique and novel claim limitations of Claim 7 and are therefore patentable over the *Rodesch* reference and the allegedly admitted prior art cited by the Examiner, either separately or in combination.

The Applicant notes that Claim 13 contains unique and novel claim limitations that are analogous to the unique and novel claim limitations of Claim 1. Therefore, Claim 13 is patentable over the *Rodesch* reference and the allegedly admitted prior art cited by the Examiner, either separately or in combination. The Applicant notes that Claims 14-19 depend directly or indirectly from Claim 13. Therefore, Claims 14-19 also contain the same unique and novel claim limitations of Claim 13 and are therefore patentable over the *Rodesch* reference and the allegedly admitted prior art cited by the Examiner, either separately or in combination.

The Applicant notes that Claim 20 contains unique and novel claim limitations that are analogous to the unique and novel claim limitations of Claim 1. Therefore, Claim 20 is patentable over the *Rodesch* reference and the allegedly admitted prior art cited by the Examiner, either separately or in combination. The Applicant notes that Claims 21-24 depend directly or indirectly from Claim 20. Therefore, Claims 21-24 also contain the same unique and novel claim limitations of Claim 20 and are therefore patentable over the *Rodesch* reference and the allegedly admitted prior art cited by the Examiner, either separately or in combination.

The Applicant respectfully submits that the rejection of Claims 1-24 under 35 U.S.C. § 103(a) has been overcome and that Claims 1-24 are in condition for allowance. Allowance of Claims 1-24 is respectfully requested.

The Examiner also rejected Claims 5, 6, 11, 12, 18 and 19 under 35 U.S.C. § 103(a) as being obvious over *Rodesch* and in view of "Admit prior Art (APA)" and further in view of *Hunt*. The Applicant respectfully traverses the Examiner's position that the Applicant's invention is obvious in view of the *Rodesch* reference and in view of the allegedly admitted prior art and in view of the *Hunt* reference.

The Applicant reiterates the arguments that the Applicant has previously made with respect to the *Rodesch* reference and the allegedly admitted prior art cited by the Examiner. The Applicant respectfully traverses the Examiner's assertion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device taught by *Rodesch* to include an application program interface (API) for a digital audio playback device and then (1) to display a graphics file that comprises a logo image associated with a manufacturer or (2) a Universal Resource Locator (URL) associated with an Internet web site.

The *Hunt* reference merely mentions that "Multimedia works are works containing more than one "media" such as text, sound, video, still and animated graphics, etc." (*Hunt*, Column 1, Lines 14-16). The *Hunt* reference also mentions that multimedia works can be delivered over Internet web pages. (*Hunt*, Column 1, Lines 16-19). There is nothing in the *Hunt* reference that suggests or even hints at the unique and novel limitations of the Applicant's invention. There is nothing that suggests or even hints at combining the *Hunt* reference with the *Rodesch* reference or with the alleged admitted prior art cited by the Examiner. The Applicant therefore respectfully submits that Claims 5, 6, 11, 12, 18 and 19 are not obvious under 35 U.S.C. § 103(a).

The Applicant again respectfully submits that the rejection of Claims 1-24 under 35 U.S.C. § 103(a) has been overcome and that Claims 1-24 are in condition for allowance

The Applicant's attorney has made the amendments to the specification and drawings and has made the arguments set forth above in order to place this Application in condition for allowance. In the alternative, the Applicant's attorney has made the amendments to the specification and drawings and has made the arguments to properly frame the issues for appeal. In this Amendment, the Applicant makes no admission concerning any now moot rejection or objection, and affirmatively denies any position, statement or averment of the Examiner that was not specifically addressed herein.

SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of pending claims and that this Application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***wmunck@davismunck.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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